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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,761	03/30/2001	Akihiro Furukawa	109133	3856
25944	7590	01/25/2006	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			ZHONG, CHAD	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/820,761	FURUKAWA ET AL.	
	Examiner	Art Unit	
	Chad Zhong	2152	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL ACTION

1. Claims 2, 3, and 7 are presented for examination, this action is responsive to communications: Amendment, filed on 12/05/2005. The action has been made final

2. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Related Art (hereinafter AARA), in view of Deering, RFC 966, 1985.

5. As per claim 2, AAPA teaches an IP address setting device:

a request packet transmitting unit that transmits a request packet to a particular broadcast address, the request packet requesting transmission of an MAC address from each node of the network (Fig 1, wherein the requests and responses are done in broadcast);

a response reception unit that receives responses from the nodes to the request packet transmitted by the request packet transmitting unit, each response including the MAC address of the corresponding node (Fig 1, wherein the MAC addresses are returned);

Art Unit: 2152

an address information designation unit that, based on the responses received from the nodes by the response reception unit, designates a node to be set with address information including an IP address and that designates the address information (Fig 1, wherein the IP addresses of the nodes are set); and

a setting packet transmission unit that transmits a setting packet to the particular broadcast address, the setting packet including the address information set by the address information designation unit and the MAC address included in the response from the node (Fig 1).

wherein the address information designation unit includes:

a display that displays a list with at least a portion of nodes that transmitted response packets (AARA, pg 1 specification, lines 14-20);

a selection unit that enables a user to select from the list the node to be set with address information (AARA, pg 1, specification, lines 14-20); and

an address information setting unit that sets address information separately to the selected node (AARA, Fig 1, wherein the IP address of the network devices are set in accordance with the received MAC address).

AAPA use broadcast instead of Multicast to transmit the request and setup packets

However, Deering teaches using multicast in place of broadcasting packets within the network in order to reduce overhead and network latency (Deering, see for example, pg 12, 1st paragraph).

It would have been obvious to incorporate Deering with teachings of AARA because the combination would allow reduction in overhead on the network. Multicast requires a designated multicast address (pg 7, 4th paragraph), hence, AARA as modified would have had a designated multicast address for transmit the request and setting packets as claimed.

6 As per claim 7, the claim is rejected for the same reasons as rejection to claim 1 above, in addition, the judging and setting limitations are disclosed in AARA's Fig 1.

Art Unit: 2152

7. Claim 3, is rejected under 35 U.S.C. 102(e) as being unpatentable over AARA – Deering, as applied in claim 1 and 7 above, in view of Boucher et al. (hereinafter Boucher), US 6,434,620.

8. As per claim 3, AARA and Deering does not explicitly say the address information designation unit includes a display unit that displays in a list at least a portion of network printers at nodes that transmitted a response packet, even though AARA shows strong motivation of doing so as the printer MAC addresses are sent back to the host computer. Moreover, within Applicant's Specification, host computer 300 is said to have a display device.

Boucher teaches displaying at least a portion of network nodes that transmitted a response packet (Col. 56, lines 51-63, wherein the network monitoring aspect of Boucher displays the response received).

It would have been obvious to incorporate Boucher with AARA – Deering because the combination would improve the display capabilities of AARA – Deering in order to provide for appropriate display of the network conditions (Boucher, Col. 56, lines 40-65).

Response to Arguments

9. Applicant's remarks filed 12/05/2005 have been considered but are found not persuasive

10. In the remark, the applicant argued in substance:

1) There is no motivation to combine teaching of AARA – Deering because Deering attempts to restrict a transmission to all of the hosts by using a multicast because broadcast communicates with all hosts.

In response to Applicant's arguments:

1) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to

Art Unit: 2152

do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the reference is to reduce the overhead within the network by using multicasting.

In response to applicant's argument that Deering failing to teach certain embodiments as disclosed within applicant's invention, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In other words, Deering provides motivation to combine with AARA because multicast can be substituted for broadcast for efficiency reasons, moreover, AARA teaches all of the limitations with the exception of multicasting.

11. **THIS ACTION IS MADE FINAL.** Applicant is reined of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2152

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents and publications are cited to further show the state of the art with respect to

“Device and Method for using MAC address of networked devices to set IP addresses”.

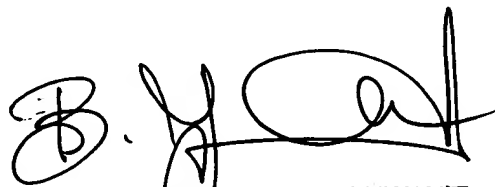
- | | | |
|------|------------|------------------|
| i. | US 5982773 | Nishimura et al. |
| ii. | US 5835725 | Chiang et al. |
| iii. | US 6577642 | Fijolek et al. |
| iv. | US 6640251 | Wiget et al. |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAROENCHONWANIT, BUNJOB can be reached on (571)272-3913. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CZ
January 23, 2006


BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER